

## **REMARKS**

### Office action summary

Claims 29-31, 36-37, and 42-56 are pending in the present application. Claims 50-52 and 55 are presently amended. No claims are presently added or canceled. The following rejections were made in the office action of December 28, 2009 (“Office Action”):

- Claims 29-30, 36-37, 43-35, 47-51, and 54-56 were rejected under 35 USC § 102(b) as being anticipated by Barry et al, US Patent 5,859,711 (“Barry”).
- Claims 42, 46, and 53 were rejected under 35 USC § 103(a) as being unpatentable over Barry in view of Kito, US Patent 6,628,899 (“Kito”).
- Claims 31 and 52 were rejected under 35 USC § 103(a) as being unpatentable over Barry in view of Nagasaka, US Patent 5,333,246 (“Nagasaka”).

The rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants’ undersigned attorney, Jon M. Isaacson, at **206-332-1102**.

### Telephonic interview

On February 16, 2010, applicants’ undersigned attorney, Examiner Nguyen, and Examiner Poon conducted a telephonic interview. Applicants’ undersigned attorney would like to thank the examiners for granting the interview. During the interview, applicants’ arguments were discussed without reaching any formal agreement. Any further substance of the interview is incorporated into the remarks below.

### Claim amendments

Claims 50-52 and 55 are presently amended. Applicants respectfully submit that the present amendments are directed to matters of form, and do not affect the propriety of the present rejection. Accordingly, applicants respectfully request entry of the present amendments despite the fact that the present Office Action is final. (See MPEP §§ 714.12 and 714.13.)

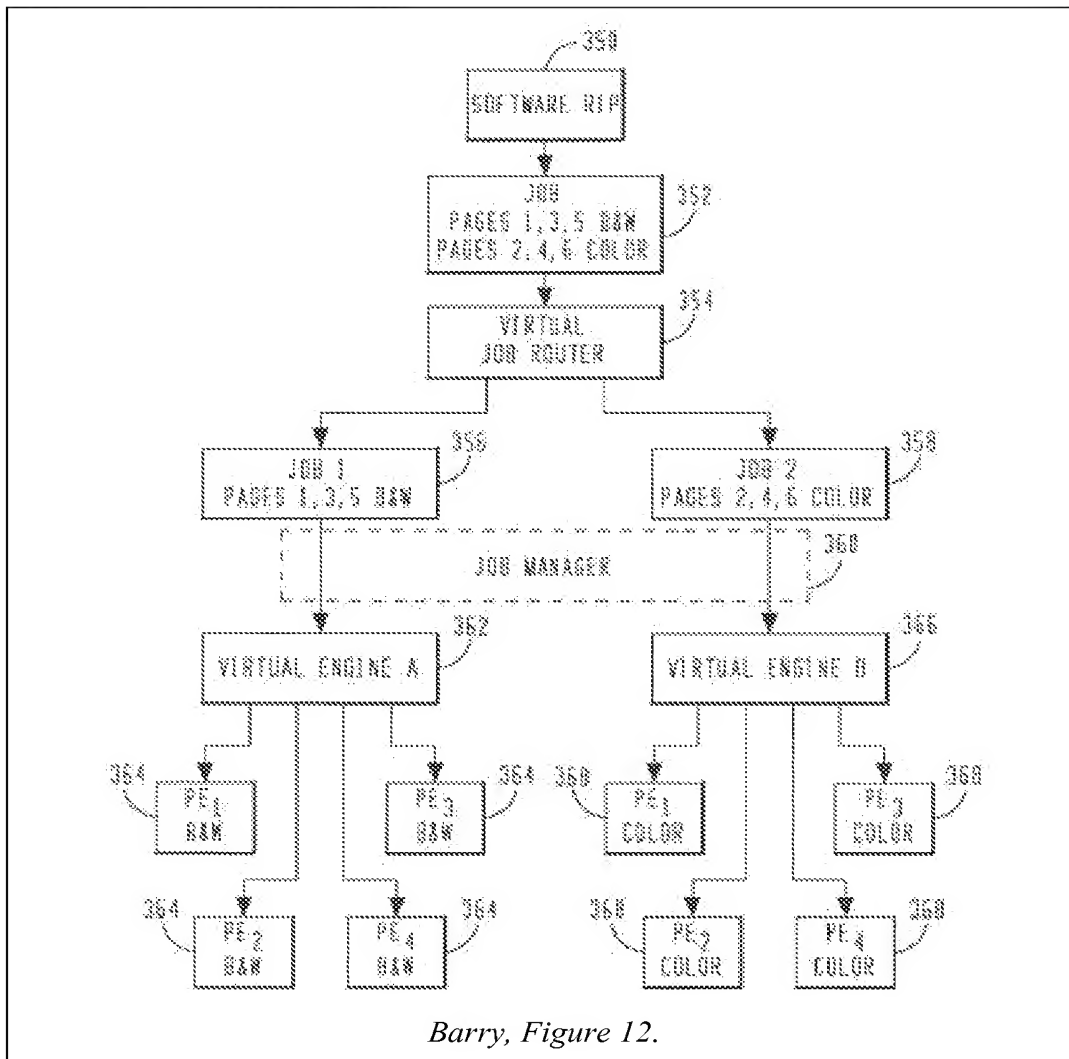
Rejections under 35 USC § 102(b) and 103(a)

**Claim 29** stands rejected under 35 USC § 102(b) as being anticipated by Barry. For a reference to anticipate a claim, the reference must disclose each and every element of the claim expressly or inherently: “[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (MPEP § 2131 (citing *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814, F.2d 628, 631 (Fed. Cir. 1987) (emphasis added)); see also *In re Crish* 393 F.3d 1253, 1256 (Fed. Cir. 2004) and *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).) For the reasons set forth below, Barry fails teach each and every element set forth in claim 29 and, therefore, Barry fails to anticipate claim 29.

Claim 29 is generally directed to a “computer-implemented method for printing a plurality of digital images.” The method comprises “determining a subset of the plurality of digital images which require image processing to meet a defined image parameter,” “performing image processing on the digital images in the subset to produce a first plurality of processed images,” and “printing the first plurality of processed images.”

In the rejection of claim 29, the Office Action relies heavily on the elements shown in Barry’s Figure 12, which is reproduced here for convenience. The Office Action argues that Barry’s Software RIP 350 determines a subset (Job 2 358) of a plurality of images (Job 352) to be printed. (Office Action, page 2.) Further, the Office Action argues that Virtual Job Router 354 performs image processing on Job 352 by routing the individual pages to Job 1 356 and Job 2 358. (*Id.* at pages 2-3.) Finally, the Office Action argues that Barry teaches that the pages in Job 2 require image processing to meet an image parameter because Barry teaches that “multiple pages of images are separate and distinct and have associated therewith parameters that define the nature of the document as to printing, col. 14, lines 55-60.” (Office Action, page 2.)

In contrast to the arguments in the Office Action, Barry fails to teach “determining a subset of the plurality of digital images which require image processing to meet a defined image parameter,” and “performing image processing on the digital images in the subset,” as recited by claim 29. In the portion of Barry cited in the Office Action, Barry merely describes that the pages have parameters that define the nature of the document; essentially,



Barry teaches that the pages have definable characteristics. Barry further describes that the virtual job router 354 parses the pages two or more groups based on those definable characteristics. (Barry, col. 14, lines 56-61.) However, Barry fails to teach that those definable characteristics necessarily mean that the pages “require image processing to meet a defined image parameter,” as recited by claim 29. In addition, Barry does not teach any form of image processing. Merely parsing the pages into at least two groups based on some characteristic of the pages does not involve any image processing. Thus, Barry also fails to teach “performing image processing on the digital images in the subset,” as recited by claim 29.

For at least the foregoing reasons, applicants respectfully submit that Barry fails to teach each and every recitation of claim 29. Therefore, Barry fails to anticipate claim 29. In addition, Kito and Nagasaka fail to cure the deficiencies in Barry. Accordingly, applicants respectfully request withdrawal of the rejection of claim 29 under 35 USC § 102(b) as being anticipated by Barry.

**Claims 36 and 50** contain recitations similar to those recitations of claim 29 discussed above. Inasmuch as Barry fails to anticipate claim 29, applicants submit that Barry fails to anticipate claims 36 and 50. Therefore, applicants respectfully request withdrawal of the rejection of claims 36 and 50 under 35 USC § 102(b) as being anticipated by Barry.

**Claims 30-31, 37, 42-49, and 51-56** depend, directly or indirectly, from claims 29, 36, and 50. Inasmuch as claims 30-31, 37, 42-49, and 51-56 depend from independent claims which are patentably defined over the cited art, applicants submit that claims 30-31, 37, 42-49, and 51-56 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 30-31, 37, 42-49, and 51-56 under 35 USC §§ 102(b) and 103(a).

#### Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 29-31, 36-37, and 42-56 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

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